

Application no. 09/352,734  
Am dt. dated Oct. 13, 2005  
Reply to Office Action of June 17, 2005

### REMARKS/ARGUMENTS

#### A. Introduction

Applicants respectfully thank the Examiner for taking the time to discuss over the phone the issues regarding this application. In the Office action of June 17, 2005, claims 1-19 and 11-15 were rejected under 35 USC § 103(a) as being unpatentable over Schmid et al. (US Patent No. 5,659,164) in view of Melen (US Patent No. 6,426,806).

#### B. Claims 1-9 and 11-15 Canceled

Applicants respectfully submit that claims 1-9 and 11-15 are canceled.

#### C. New Claims Added

Applicants respectfully submit new claims 16-35. No new matter has been added.

To clarify how the new claims are patentably distinguishable from the prior art cited, the Applicants respectfully submit that a more detailed discussion of the Applicants' specification and the prior art may be helpful. In particular, as per phone interview with the Examiner on Oct. 4, 2005, Applicants respectfully submit that the embodiments of the present invention include (a) having at least one control sheet and (b) having the control sheets associated with the stack of documents.

Schmid discloses a method of identifying "the beginning and ending of a logical group of pages during digital scanning." (Schmid, col. 1, lns. 14-16). Schmid discloses a method wherein each logical group of pages is identified by using an associated cover page, i.e., a cover page — set as the first page of each logical group. The cover sheet bears "machine-readable code markings containing identification of the document owner and desired routing of the digital information" (Schmid col. 3, lns. 27-39). Kindly note that Schmid sometimes uses the term "document" to mean a logical group or set of pages. Schmid further discloses that the "top sheet and all other logical sets of sheets within the stack" are preceded with a cover sheet (Schmid, col. 3, lns. 35-37). The stack of sheets are scanned with a digitizing scanner and "upon the identification of a new cover sheet or the absence of further sheets fed to the scanner," Schmid discloses that "all sheets scanned from the previous cover page" are

Application no. 09/352,734  
Amdt. dated Oct. 13, 2005  
Reply to Office Action of June 17, 2005

considered as one document" or one logical group and thereupon the digitized document, i.e., the logical group of pages, is routed in accordance with the "cover sheet identification-routing information." (Schmid, col. 3 lns. 41-52) (See Schmid col. 3 lns. 27-52).

Described in another way, Schmid discloses one stack with multiple documents or logical groups. Each logical group is identified by placing a cover sheet, i.e., the first page preceding any pages of the logical group. Thus, if you have two logical groups within that one stack, there would be two cover sheets. The first cover sheet is required to be at the top of the stack — meaning first to be scanned, followed by the first logical group/document, followed by the second cover sheet that is required to precede the second logical group/document, and then followed by the second logical group/document. In general, the cover sheet thus functions as a divider that separates the logical groups.

Schmid discloses that when "a new cover page 1' is encountered, or the scanner" automatic document feeder (ADF) "is empty, the previous page (Pg n+1) becomes the last page of the document and all pages (now in digital format) are electronically 'stapled' or assembled into a single identifiable entity . . . which is then routed." (Schmid, col. 4, lns. 37-42). Each separate document or logical group or single identifiable entity is thus identified and separated by a cover sheet that is required to be the first page of the document/logical group. (Schmid, col. 4, lns. 46-50, Fig. 3A, Box 2).

Fig. 1 of Schmid shows a scanning job with one stack of multiple pages but with two logical groups/documents. Each logical group/document is preceded by its corresponding cover page. (Schmid, col. 4, lns. 8-13). The first document, which includes Page 1, Page 2, Page 3, Page n, and Page n+1, is preceded by a cover sheet, Cover Page 1. The second document, which includes Page 1', Page 2', Page n', and Page n+1', is preceded by a second cover sheet, Cover Page 1'. Each cover page "contains the network address or identifier" for its corresponding "document owner to whom the document is assigned or is to be routed" (Schmid, col. 4, lns. 22-26), thus Cover Page 1 contains the routing information for the first document — Page 1, Page 2, Page 3, Page n, and Page n+1, while Cover Page 1' contains the routing information for

Application no. 09/352,734  
Amdt. dated Oct. 13, 2005  
Reply to Office Action of June 17, 2005

the second document — Page 1', Page 2', Page n', and Page n+1', but NOT vice versa. Thus, each cover page is only associated or applies only to its corresponding document and not to any other document or logical group in the stack. Thus, if two cover sheets are present in the stack, each cover sheet is not associated with the entire stack but only with a portion or subset of the stack. Furthermore, Schmid requires that the cover sheet be placed as the FIRST page of the logical group; this placement is *required* so as to separate the groups from each other. Placing the cover sheet anywhere else in the stack would destroy its function of identifying the separate documents. (Schmid, col. 4, lns. 46-49).

Unlike the Applicants' disclosure, the cover sheets of the embodiments of the present invention apply to the entire stack. Thus, if Fig. 1 is an exemplary scanning job or stack using some embodiments of the Applicants' present invention, the control instructions contained in Cover Page 1 and Cover Page 1' are associated with the entire stack, meaning to all the pages within the stack or at least to all non-control sheets, i.e., Page 1, Page 2, Page 3, Page n, Page n+1, Page 1', Page 2', Page n', and Page n+1' and not just a subset or portion of the stack. In general this means that all control sheets within the stack are associated with all the sheets within the stock, or applies to at least all non-control sheet pages. Applicants respectfully submit that Schmid does not teach or even suggest this feature of the present invention and therefore claims 26-35 are patentably distinguishable from the prior art cited.

Unlike the Schmid teachings that require the cover sheet to be the first page, the Applicants further disclose a method that "allows the control sheets to be placed anywhere within a scanning job, such as a fax, copy, or scan job." (Specification, pg. 2 lns. 14-16). For example, if "a user has a monthly report that is a compilation of *several* documents, that user could create one control sheet with all the routing information on it. Every month, the user would just include the control sheet in the stack of documents" meaning anywhere in the stack — anywhere within the several pages of documents "and the monthly report will get routed appropriately." (Specification, pg. 5, lns. 14-18, emphasis added). "Once the documents are scanned, the method locates the control image. . . . In this manner, the location of the control image is not set to be at the beginning," first, or top "of the job." (Specification, pg. 5, lns. 19-

Application no. 09/352,734  
Amdt. dated Oct. 13, 2005  
Reply to Office Action of June 17, 2005

21, emphasis added). Unlike Schmid, the embodiments of the cover sheet of the Applicants do not act as a separator of logical groups or documents.

Applicants also disclose that there can be more than one control sheet. Applicants particularly disclose different types of control sheets. (Specification, pg. 7, lines 7, Fig. 3). "For example, a first control sheet could be a set of directions to operate the scanning device." (Specification, pg. 7, lns. 6-8, emphasis added). The "two sets of control images could be inserted into the scanning job simultaneously or other options for the control images could be used first." (Specification, pg. 7, lns. 17-19). "The order of the types of control sheets could be reversed. Alternatively, they could be inserted simultaneously." (Specification, pg. 8, lns. 5-7). "Simultaneously" generally means done at the same time, i.e., two control sheets may be inserted at the same time one after another. Also by stating "other options" the control sheets may be inserted in any order and be in any location in the stack.

Melen is similar to Schmid in the sense that Melen's control sheets function also as dividers between multiple logical groups of documents. Melen stated that "with either of these conventional systems . . . , a user may not place a number of separate documents, each with a separate destination, into the scanner and expect the scanned document information to arrive at the correct location without further intervention." (Melen, col. 1, lns. 31-36). Melen further stated that what "is needed is a scanning system which allows a user to communicate a desired destination for a scanned document in a way which allows the destination information to stay with the physical document. This would allow a set of documents, each with a unique destination, to be scanned and routed automatically, without further user intervention." (Melen, col. 1, lns. 46-52). In fact, Melen stated, as per the Office action, that the "control sheet 102 may be fed into the scanner 106 either immediately prior or immediately following document 104 being fed into scanner 106." Melen also stated that "information contained in control sheet 102 can indicate whether it is associated with the preceding or following document." (Melen, col. 2, lns. 35-37).

Application no. 09/352,734  
Amdt. dated Oct. 13, 2005  
Reply to Office Action of June 17, 2005

The Office action also stated, that it would have been obvious to modify Schmid by positioning the control sheet in the position other than the first page of the imaging job [i.e., placing control sheet 102 following the document 104] as taught by Melen (Office action, pg. 4, lns. 4-8).

Applicants respectfully submits that the pending claims are distinguishable from the prior art cited. Schmid and Melen do not teach being able to handle a stack of documents wherein the control sheet or sheets are placed anywhere in the stack. To do so would definitely teach away from Schmid and Melen because placing the cover sheet anywhere in the stack would destroy the association between the control sheet and its corresponding logical group of documents. Furthermore, Schmid and Melen do not teach having more than one control sheet per logical group or having more than one control sheet associated with the entire stack, as disclosed by the Applicants. Furthermore, Schmid and Melen do not teach having a cover sheet interposed in the middle of a logical group of documents, i.e., other than the first page and other than the last page, as disclosed by the Applicants.

As to claim 16, Schmid and Melen, individually or in combination, do not teach that the control sheet be placed in the middle of a logical group. Thus, claim 16 is patentably distinguishable.

Claims 17-26 depend from claim 26 and thus incorporate the limitations of the base claim, i.e., Claim 26. As discussed above, the references cited do not teach the limitations of the base claim much less the further embodiments of the dependent claims. Claims 17 -26 therefore should also be allowed.

As to claim 27, Schmid, even in combination with Melen, do not teach two or more control sheets. Thus, claim 27 is patentably distinguishable.

Claims 28-34 depend from claim 27 and thus incorporate the limitations of the base claim. As discussed above, the references cited do not teach the limitations of the base claim much less the further embodiments of the dependent claims, and thus should also be allowed.

Application no. 09/352,734  
Amdt dated Oct. 13, 2005  
Reply to Office Action of June 17, 2005

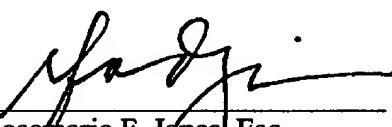
As to claim 35, Schmid, even in combination with Melen, do not teach placing the control sheet anywhere within the stack. To do so would teach away from the teachings of Schmid and Melen. Applicants respectfully submit that claim 35 should also be allowed.

D. Conclusion

Applicant respectfully requests allowance for all pending claims. No new matter has been added. Should there be any other fees due for this Office action, your office is authorized to draw from the firm deposit account number 02-3979. Should you have any questions, or identify any problem, I would appreciate a telephone call so that this matter may be resolved promptly, particularly so that the claims be placed in a condition for allowance.

Respectfully submitted,

Michael Blaine Brooks, PC

By: 

Rosemarie F. Jones, Esq.  
Reg. No. 46,253  
1445 E. Los Angeles Ave.  
Suite 206  
Simi Valley, CA 93065  
Tel.: (805)579-2500